

**REMARKS**

**I. Status of the Claims**

Claims 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 80-84 are currently pending, with claims 80-84 being withdrawn as directed to non-elected subject matter. No amendments are made at this time.

**II. Rejection under 35 U.S.C. § 103(a)**

The Office maintains the rejection of claims 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as allegedly "being obvious over" U.S. Patent Nos. 6,635,702 (the '702 patent) and 5,580,494 (the '494 patent), as well as WO 2002/096385 (WO '385) and WO 2002/096377 (WO '377) for the reasons set forth in the Office Action at pages 2-10.

Applicants note that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(l) (8th ed. Sept. 2007 Rev.) (emphasis in original) (citations omitted). Further, the Office must "[c]onsider any teachings of a 'typical,' 'preferred,' or 'optimum' species or subgenus within the disclosed genus." M.P.E.P. § 2144.08.

In response to Applicants' arguments that the Office has simply used picking and choosing to select clays and/or calcium carbonate from the '702 patent, the Office contends that the '702 patent "**suggests** adding calcium carbonate" and states that "[t]he purpose of adding calcium carbonate (insoluble compounds) is to provide

stabilization." Office Action, page 7 (emphasis original). Applicants note, however, that the passage cited by the Office actually states: "Insoluble Materials or Compounds... require stabilization." The '702 patent, col. 8, line 15 (emphasis added). As such, the Office's assertions are mistaken.

The Office also points to "example 3B which has insoluble components mica, titanium dioxide and iron oxide" and argues that "the examples [of the '702 patent] definitely direct one skilled in the art to choose [a] functional equivalent since substituting calcium carbonate would also produce stable formulations." Office Action, page 8. The Office states that WO '377 "clearly teaches claimed 10 % weight of calcium carbonate provide hair with texture and better hairstyle hold." *Id.* Accordingly, it appears as though the Office is making an "obvious to try" argument.

Obvious to try rationales can only be supported when there is a finite number of identified, predictable potential solutions to the recognized need or problem. M.P.E.P. § 2143(E). However, in this case, a finite number of predictable potential solutions does not exist. Rather, there are a wide variety of solutions to hairstyle problems, as one of skill in the art would recognize, and further, arriving at those solutions is not predictable.

For example, the passage cited by the Office of WO '377 itself states that its particular solution was "surprisingly and unexpectedly" discovered. PGPUB '335 at para [0011]. Indeed, that same passage further states that "by carefully selecting the surfactant base and the conditioner, combined with the calcium carbonate particles, it is possible to improve the results obtained with cosmetic products." *Id.* (emphasis added). As such, WO '377 actually attests to the unpredictability in the art and would not lead

one to believe it is obvious to add calcium carbonate to the formulation in the '702 patent.

Finally, to demonstrate further that there is no *prima facie* case of obviousness because of lack of predictability, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 of Samira Khenniche dated March 16, 2009 ("Declaration"). The Declaration demonstrates the difference in softness, smoothness, suppleness in both wet and dry hair as well as texture in dry hair between comparative Composition A and inventive Compositions B and C. See Declaration at ¶¶ 5 and 6 and Table 1. As shown in Table 1, Composition A and Compositions B and C were identical except that Composition A (comparative) contains mica-TiO<sub>2</sub> as a water-insoluble solid mineral particle while Composition B (inventive) contains calcium carbonate and Composition C (inventive) contains clay, according to the present claims. See *id.*

The cosmetic properties of the hair were evaluated by seven experts. See Declaration at ¶ 8. The wet hair was evaluated for softness, smoothness, and suppleness. See *id.* After the locks were dried, the hair was evaluated for softness, smoothness, suppleness, and texture. See *id.* The results were ranked from 0-5 with zero representing "not good" and five representing "excellent." See *id.* The overall results show statistical and/or numerical differences between comparative Composition A and inventive Compositions B and C. See *id.* at Tables 2 and 3. For example, the softness of dried hair is statistically different for the comparison of Composition A (comparative) and Composition B (inventive) as well as for the comparison of Composition A (comparative) and Composition C (inventive). See *id.* Even where the results are not statistically significant, numerical differences can be informative. See

*Abbott Laboratories vs. Sandoz Inc.*, 544 F.3d 1341 (Fed. Cir. 2008), where Judge Newman did not require a showing of statistically significant differences in comparative testing; numerical differences were enough. Thus, from the results as a whole, the Declarant testifies that there is a marked improvement of the cosmetic properties in the hair treated with inventive Composition B and inventive Composition C. See *id.* at Tables 2 and 3, and ¶ 9.

Because one of skill in the art would not have been able to predict those improved cosmetic properties, there were no identifiable predictable solutions, particularly in view of the teachings identified above of WO '377. Hence, the Office has failed to make a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **III. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a phone call would be useful in resolving the outstanding issues, she is respectfully invited to contact the undersigned at 202-408-4368.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: March 18, 2009

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**Attachments:** Declaration under 37 C.F.R. § 1.132 of Samira Khenniche